UNITED STATES PATENT AND TRADEMARK OFFICE

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09/940,764	08/27/2001	Abhay V. Parasnis	020431.0774	5771

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i2 TECHNOLOGIES US, INC.
ONE i2 PLACE, 11701 LUNA ROAD
DALLAS, TX 75234

EXAMINER
HAQ, NAEEM U

ART UNIT	PAPER NUMBER
3625	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>07 May 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,5,6,10,14,15,19,23,24 and 28-31* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,5,6,10,14,15,19,23,24 and 28-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

This action is in response to the Applicants' amendment filed on May 7, 2007.

Claims 2-4, 7-9, 11-13, 16-18, 20-22, and 25-27 have been canceled.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9, 28, and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims are directed to a "system". However, the body of the claims recites an "engine" and a plurality of "tiers". None of the components constitute a structural element (i.e. physical element). Therefore, it is unclear to the examiner how these components can be regarded as a "system". Furthermore, claims 1 and 29 recite the limitations "data and metrics meta-model", "state transition meta-model", and "workflow meta-model". It is unclear to the examiner what these terms mean.

Referring to claim 28: This claim invokes 112, 6th paragraph by reciting a series of "means plus function" language. However, the Applicants' specification discloses that the "structure" being relied upon to perform the action is nothing more than software

(see specification page 8, lines 30-32; page 9, lines 15-17; page 12, lines 6-8). It is

unclear to the examiner how software can constitute a "system".

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
conditions and requirements of this title.

Claims 1-9, 28, and 29 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.

As noted above in the 112, second paragraph rejection, the Applicants' invention

is directed to "system". However, the claims fail to recite any physical structure.

Accordingly, these claims are directed non-statutory subject matter.

Referring to claim 28: This claim invokes 112, 6th paragraph by reciting a series

of "means plus function" language. However, the Applicants' specification discloses

that the "structure" being relied upon to perform the action is nothing more than software

(see specification page 8, lines 30-32; page 9, lines 15-17; page 12, lines 6-8). The

examiner that software (i.e. computer code) is not a physical or tangible structure, and it

cannot be relied upon to define a "system".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 5, 6, 10, 14, 15, 19, 23, 24, and 28-31 are rejected under 35 U.S.C.

103(a) as being unpatentable over Gardner et al. (US 5,758,327)("Gardner") in

view of Adams et al. (7,117,165 B1) ("Adams").

Referring to claims 1, 5, 6, 10, 14, 15, 19, 23, 24, and 28-31: Gardner teaches a

request for quote engine comprising: a data and metrics designer operable to generate,

in response to input from a user, a data and metrics model for an RFQ template using a

data and metrics meta-model. The Applicant's specification teaches that the data and

metrics designer can be "...*tailored to capture selected structured and unstructured data relating to*

an RFQ or other business process." (see specification page 7, lines 11-13). The Applicant's

specification also teaches that the data and metrics model can include "...*details relating to*

the RFQ (such as product or service requirements, due dates, and participation rules and restrictions),

demand data (such as the required quantity of a product or service over a period of time), and various

attachments (such as a design document, legal terms, and shipping/logistics details). As can be seen

from these examples, the collected data may be structured (for example, the delivery date may be

entered in a specific format and the price may be entered in a particular currency) and/or unstructured (for

example, an attachment such as a text document)." (see specification page 7, lines 15-22.

Gardner teaches requisition rules that may require an attachment (col. 2, lines 57-61;

col. 3, lines 18-31). Gardner also teaches a state transition designer operable to

generate, in response to input from the user, a state transition model for the RFQ

template using a state transition meta-model. The Applicant's specification teaches the

state transition designer and model can be "...*tailored by a business to execute an appropriate*

sequence and type of communications between the business and a supplier regarding a RFQ generated

by the business." (see specification page 3, lines 26-29; page 8, lines 4-8). Gardner

teaches that the requisition rules include an authorization matrix that identifies a person-

to-person sequence for the requisition (col. 3, lines 32-43). Finally, Gardner teaches an

execution engine operable to execute the RFQ template comprising the data and

metrics model generated by the data and metrics designer, the state transition model

generated by the state transition designer, the RFQ template being executed to

generate an RFQ (col. 7, lines 12-17). Gardner does not teach a workflow designer

operable to generate, in response to input from the user, a user interface workflow for

the RFQ template using a workflow meta-model. However, the Applicant's specification

teaches that interface workflow designer "...*may be configured to provide a "wizard" interface*

that takes the users through a series of easy to follow steps to complete an RFQ or to evaluate responses

to an RFQ." (see specification page 8, lines 21-24). Adams, on the other hand, teaches

an operating resource management system that allows a user of the system to use a

"wizard" to prepare a requisition (col. 3, lines 9-56). Therefore it would have been

obvious to one of ordinary skill in the art, at the time the invention was made, to

incorporate the wizard of Adams into the invention of Gardner. One of ordinary skill in

the art would have been motivated to do so in order to guide a user through a series of

questions at each step, providing navigational aids to keep track of the big picture, and

presenting lists of choices whenever possible instead of asking the employee to type

things in, as taught by Adams (col. 7, lines 29-33). Finally, the examiner notes that the Applicant's specification discloses that the terms "request for quote" and "RFQ" refer not only to request for quotes, "...*but to any other appropriate business transactions originated by an originating entity 4 and communicated to a responding entity 6 for a response that addresses one or more parameters of the business transition specified by originating entity 4.*" (see specification page 6, lines 7-11). Based on this description, the examiner notes that a requisition is equivalent to an RFQ. The cited prior art does not teach that the RFQ engine is logically organized into one or more tiers. However, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to arrange the software applications of the cited prior art into tiers. Applicant has not disclosed that the tier organization provides an advantage, is used for a particular purpose or solves a stated problem. Furthermore, one of ordinary skill in the art would have expected Applicants' invention to perform equally well using any other arrangement because the functionality of a program is not dependent on how the program is logically organized. Therefore, it would have been obvious to one of ordinary skill in this art to modify the cited prior to obtain the invention as specified in the claims.

Response to Arguments

Applicants' arguments have been fully considered but they are not persuasive. The Applicants have argued that the limitation "...workflow tier operable to generate, in response to input from the user..." is not taught by the prior art. In response to this argument, the examiner notes that the intended use of the claimed invention must result

in a structural difference between the claimed invention and the prior art in order to

patentably distinguish the claimed invention from the prior art. If the prior art structure is

capable of performing the intended use, then it meets the claim. Since the claimed

feature is "operable to generate", the examiner deems this to be an intended use of the

system.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Naeem Haq whose telephone number is (571)-272-

6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jeffrey A. Smith can be reached on (571)-272-6763. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NAEEM HAQ
PRIMARY EXAMINER

July 23, 2007